

REMARKS

The Office Action of November 17, 2006 has been reviewed and the comments therein were carefully considered. Claims 1-27 and 56-75 are pending in this application. Claims 1-27 and 56-75 stand rejected. No new subject matter has been added.

Rejections under 35 U.S.C. § 103

Claims 1-7, 10-11, 13-15, 17-24, 26-27, 56-57, 59, 60-62, 64-66, 68-75 stand rejected under 35 USC Section 103(a) as being unpatentable over Durst, Jr. et al. (U.S. Patent No. 6,542,933) in view of Sussman (U.S. Patent Application No. 2001/0161658). In view of the Remarks below, the Applicants respectfully request reconsideration.

First, Applicants respectfully submit that one skilled in the art would not be motivated to combine the teachings of Durst with the teachings of Sussman to arrive at the subject matter of the rejected claims. Second, even upon combining Sussman with Durst, the subject matter of the rejected claims is not obtained. As set forth in the Background of the Invention of the instant application, aspects of the invention are directed towards solving “a need for a system and method by which a user may obtain more information regarding a consumer item which the user may consider and digest in the comfort of the user’s home” or other locations away from the product or service the user is contemplating purchasing or otherwise utilize. (Spec., page 4, paragraph 6).

In stark contrast, Sussman merely allows a user to maintain a “shopping list” of items the user already intends on purchasing. Sussman states:

As attested in the Background of the Invention, one of the greatest hassles in shopping is remembering what you must buy. The simplest way is to write down a list of items on a piece of paper from which you cross off items as you buy them. One of the problems with this method is the case when you are compiling the list of a period of time, e.g. days. In this case you need to remember where you put your slip of paper and preferably keep it at hand wherever you are. Inspiration tends to arrive at odd and unexpected moments.

(Page 3, paragraph 22, emphasis added). The embodiments subsequently described in Sussman only describe a system and method for “solv[ing] this problem, i.e., maintaining the shopping list.” (Sec. page 3, paragraph 26). In fact, the specification makes it clear the “scanner” of

Sussman is merely intended to create a shopping list of products the user already has intended to buy. As provided in paragraphs 26 and 27, which reference to FIGS. 1 and 2, as does the cited text cited by the Office Action:

[T]he preferred embodiment of the invention solves this problem, i.e. maintaining the shopping list, with the following method and system. The consumer primarily uses a small wireless bar code scanner 17 that he uses to scan in merchandise UPCs 14 and or catalog UPCs 15, depending on whether he is shopping via a store 24, MOTO 25 or on a web store 10...This means that (a) mail order catalogs/newspaper advertisements 99 need to include UPC barcodes and (b) web pages need to include UPC barcodes as well, that can be scanned, or transferred, to the barcode scanner 17.

Thus, the user merely “maintains the shopping list” by adding UPCs from sources that already provide information, such as a catalog, web store, mail order/telephone order sources, and the like. There is no indication that they are scanning in products or services that they desire additional information about. In fact, the catalog, newspaper, and/or webpage the user presumably located themselves appears to be the only product information being supplied to the user. This interpretation is further supported in paragraph 29, in which the already purchased product is scanned upon depletion of the product, and or situations where a replacement is required. It logically follows that if the user has already purchased the product (or in some instances, utilized the product) and thus intends on purchasing a replacement, the “shopping list” of Sussman is drastically different than that of the subject matter of both Durst and the rejected claims.

This is further reinforced throughout Sussman when discussing the single preferred embodiment. For example, Table 3 shows the “Preferred Embodiment’s Grocery Shopping Experience Process – The New Shopping Experience.” As shown, the user selects the item in step 1 (“item has run out or needs to be replaced shortly”) and transmits the list later in step 4. The same holds true for the Drive-Thru Delivery Method shown in Table 4, where the user transmits its order to purchase in step 1, thus indicating no further information is being requested by the user to contemplate purchasing the item, rather the user has already determined to purchase the item.

Thus, one skilled in the art would not be motivated to even combine Sussman with Durst. Specifically, in contrast with the “shopping list” of Sussman “[t]he system of [Durst] is designed

as an aid to individuals who are looking for data content such as a web page (referred to as primary content)” for more information. (Col. 4, line 65 to Col. 5, line 1).

Along these lines, one skilled in the art would also not be motivated to arrive at the subject matter of the rejected claims upon reading the teachings of Sussman. In fact, combining Sussman with Durst still does not arrive at the subject matter of the present invention. The output devices coupled to the scanner of Sussman will merely provide a print out or screen shot of the “shopping list” for the items the user already has decided to purchase. Further, as discussed in previous Responses, there is no teaching of an information server system that determines a desired communication method from multiple communication methods and then transmits P/S--Info using the determined communication method as recited for example in independent claims 1 and 56. If the rejection is maintained, Applicants request clarification how the Examiner believes this limitation is met with the teachings of Durst as alleged in the Office Action.

Claims 8-9, 12, 16, 25, 58, 63, 67 stand rejected under 35 USC Section 103(a) as being unpatentable over Durst, Jr. et al. (U.S. Patent No. 6,542,933) in view of Sussman (U.S. Patent Application No. 2001/0161658) and further in view of Gottsman et al. (U.S. Patent No. 6,134,548).

As discussed above, there is no motivation to combine Sussman with Durst, and even upon combining Sussman with Durst, the subject matter of the rejected claims is not obtained. Further, as discussed in the previous Responses, Gottman relates to a system that facilitates interactive web-based comparison-shopping in conventional, physical, non-web retail environments (see col. 1, lines 54-57). Gottman (col. 1, lines 57-63) discloses that a wireless phone or similar hand-held wireless device with Internet Protocol capability is combined with a miniature barcode reader (installed either inside the phone or on a short cable) and utilized to obtain definitive product identification by, for example, scanning a Universal Product Code (UPC) bar code from a book or other product.

Gottman (col. 1, lines 63-67) teaches that the wireless device transmits the definitive product identifier to a service routine (running on a Web server), which converts it to (in the case of books) its International Standard Nook Number or (in the case of other products) whatever identifier is appropriate. Gottman (col. 1, line 67 thru col. 2, line 5) further states, “the service

routine then queries the Web to find price, shipping and availability information on the product from various Web suppliers. This information is formatted and displayed on the hand-held device's screen. The user may then use the hand-held device to place an order interactively".

However, Gottman is silent with respect to "a server that determines a communication method from multiple communication methods and transmits P/S-info using the determined communication method," as recited in independent claims 1 and 56. Consequently, Gottman fails to provide what Durst and/or Sussman lack. As a result, amended independent claims 1 and 56 are patentable over the combination of Durst, Sussman and/or Gottman whether individually or in combination and, therefore, reconsideration and withdrawal of all the rejections under 35 U.S.C. §103 are respectively requested.

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Applicant believes there is no fee due in association with the filing of this response, however, should there be any fees due the Commissioner is hereby authorized to charge any such fees or credit any overpayment of fees to Deposit Account No. 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: February 13, 2007

By: /Shawn P. Gorman/
Shawn P. Gorman
Reg. No. 56,197
BANNER & WITCOFF, LTD.
10 S. Wacker Drive
Suite 3000
Chicago, IL 60606-7407
Telephone: 312-463-5000
Facsimile: 312-463-5001